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10/660,538	09/12/2003	Tsutomu Ohishi	242738US2	5339
22850 7590 06/09/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER RODRIGUEZ, LENNIN R				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 06/09/2011		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/660,538

**Applicant(s)**

OHISHI ET AL.

**Examiner**

LENNIN RODRIGUEZ

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,10,11,13-16,18-21,23,26 and 29-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-3,5-7,10,11,13-16,18-21,23,26 and 29-34 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/2011 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 3/24/2011 have been fully considered but they are not persuasive. Applicant's argument regarding "" has been fully considered; in response.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 11, 14, 20 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 6,141,111).

(1) regarding claims 1, 14 and 29:

Kato '111 teaches an image forming apparatus (26 in Fig. 1) comprising:

a storage part (7 in Fig. 1; column 3, lines 45-46) configured to store information of functions of a plurality of image forming apparatuses (Fig. 10, column 8, lines 56-65, table with printers information), including the image forming apparatus and other image forming apparatuses connected to the image forming apparatus via a network (Fig. 3C and Fig. 10, information about multiple printers), and information of destination addresses of the image forming apparatuses (Fig. 3C, column 4, lines 36-43, table with printing addresses);

a printing part (4 in Fig. 1) configured to perform print processing when receiving a print request and print data from a client terminal (column 6, lines 11-16);

a determination part configured to determine whether any of the plurality of image forming apparatuses has a function included in the print request based on the information of functions stored in the storage part (S27 and S28 in Fig. 9, column 8, lines 47-55, where a determination is made to choose an optimum printer); and

a print request part configured to request the printing part of the image forming apparatus to print the print data when the image forming apparatus has the function included in the print request based on the determination by the determination part (column 8, line 56 through column 9, line 25, where using a series of ranking methods an image is sent to the optimum print device), and to request one or more of the other image forming apparatuses to print the print data when the one or more of the other image forming apparatuses have the function included in the print request based on the

determination by the determination part (column 8, line 56 through column 9, line 25, where if the printing apparatus 26 is not capable of performing the image as requested other printers 27-29 are selected).

(2) regarding claim 7 and 20:

Kato '111 further discloses wherein the print request part distributes the print data and the print request by referring to the information stored in the storage unit (Fig. 3C and Fig. 10, where the print request is sent according to information stored about multiple printers).

(3) regarding claim 11:

Kato '111 further discloses wherein the print request part comprises an address obtaining part for obtaining addresses of the one or more image forming apparatuses connected to a network (Fig. 3C); and

wherein the print request part distributes the print data and the print request by using addresses obtained by the address obtaining part (column 6, lines 47-52).

(4) regarding claim 34:

Kato '111 further discloses an address obtaining part for obtaining addresses of the other image forming apparatuses automatically and periodically to generate printer list data to be stored in the storage unit, the printer list data associating names of the other image forming apparatuses with the respective obtained addresses of the other image forming apparatuses (column 4, lines 36-43, where the addresses are being acquired automatically, inherently the addresses are going to be obtained periodically in the case a new printer is connected to the system).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 2-3, 5-6, 13, 15-16, 18-19, 21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) in view of Whitmarsh (US 2002/0101608).

(1) regarding claims 2 and 15:

Kato '111 discloses all the subject matter as described above except an information providing part configured to provide, to the client terminal, screen data used for selecting one or more image forming apparatuses from among the plurality of image forming apparatuses, wherein the information providing part sends the screen data for inputting a print instruction to the client terminal; and

the print request part distributes the print data and the print request when receiving the print instruction from the client terminal.

However, Whitmarsh '608 teaches an information providing part configured to provide, to the client terminal, screen data used for selecting one or more image forming apparatuses from among the plurality of image forming apparatuses (paragraph [0035] and paragraph [0036], lines 1-4, where the user can select the destination printer among the ones shown in a list), wherein the information providing part sends the screen data for inputting a print instruction to the client terminal (paragraph [0041]-

[0042], where via a browser there is provided a screen so that the user can make choices); and

the print request part distributes the print data and the print request when receiving the print instruction from the client terminal (paragraph [0046], lines 1-7).

Having a system of Kato '111 reference and then given the well-established teaching of Whitmarsh '608 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato '111 to include an information providing part configured to provide, to the client terminal, screen data used for selecting one or more image forming apparatuses from among the plurality of image forming apparatuses, wherein the information providing part sends the screen data for inputting a print instruction to the client terminal; and the print request part distributes the print data and the print request when receiving the print instruction from the client terminal as taught by Whitmarsh '608 because with this a user will have the choice to select what printer he/she will prefer to se for printing the image.

(2) regarding claims 3 and 16:

Kato '111 discloses all the subject matter as described above except wherein the screen data used for uploading the print data to the client terminal; and

the image forming apparatus receives the print data when the print data is uploaded from the client terminal.

Whitmarsh '608 further discloses wherein the screen data used for uploading the print data to the client terminal (paragraph [0038]); and

the image forming apparatus receives the print data when the print data is uploaded from the client terminal (paragraphs [0038]-[0039]).

Having a system of Kato '111 reference and then given the well-established teaching of Whitmarsh '608 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato '111 to include wherein the information providing part sends screen data used for uploading the print data to the client terminal; and the image forming apparatus receives the print data when the print data is uploaded from the client terminal as taught by Whitmarsh '608 because with this a user will have the choice to select what printer he/she will prefer to se for printing the image.

(3) regarding claims 5 and 18:

Kato '111 discloses all the subject matter as described above except wherein the screen data includes data for displaying a plurality of image forming apparatuses and corresponding places for each of the image forming apparatuses.

Whitmarsh '608 further discloses wherein the screen data includes data for displaying a plurality of image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list) and corresponding places for each of the image forming apparatuses (paragraph [0043], where the list includes publisher address).

Having a system of Kato '111 reference and then given the well-established teaching of Whitmarsh '608 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato



'111 to include wherein the screen data includes data for displaying a plurality of image forming apparatuses and corresponding places for each of the image forming apparatuses as taught by Whitmarsh '608 because with this a user will have the choice to select what printer he/she will prefer to se for printing the image.

(4) regarding claims 6 and 19:

Kato '111 discloses all the subject matter as described above except wherein the screen data includes data for displaying a plurality of image forming apparatuses and corresponding functions for each of the image forming apparatuses.

Whitmarsh '608 further discloses wherein the screen data includes data for displaying a plurality of image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list) and corresponding functions for each of the image forming apparatuses (paragraph [0041]).

Having a system of Kato '111 reference and then given the well-established teaching of Whitmarsh '608 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato '111 to include wherein the screen data includes data for displaying a plurality of image forming apparatuses and corresponding functions for each of the image forming apparatuses as taught by Whitmarsh '608 because with this a user will have the choice to select what printer he/she will prefer to se for printing the image.

(5) regarding claims 13 and 26:

Kato '111 discloses all the subject matter as described above except wherein the image forming apparatus is configured to be able to install a plurality of applications

separately from the control services, and the image forming apparatus includes the information providing part and the print request part as an application.

Whitmarsh '608 further discloses wherein the image forming apparatus is configured to be able to install a plurality of applications separately from the control services (paragraph [0033], where different programs such as job store application can be installed), and the image forming apparatus includes the information providing part and the print request part as an application (paragraph [0043]).

Having a system of Kato '111 reference and then given the well-established teaching of Whitmarsh '608 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato '111 to include wherein the image forming apparatus is configured to be able to install a plurality of applications separately from the control services, and the image forming apparatus includes the information providing part and the print request part as an application as taught by Whitmarsh '608 because with this a user will have the choice to select what printer he/she will prefer to use for printing the image.

(6) regarding claim 21:

Kato '111 discloses all the subject matter as described above except wherein the print instruction includes an instruction for designating functions to be used for printing the print data, and

the print request part selects one or more image forming apparatuses that includes the designated functions from among the selected one or more image forming

apparatuses, and distributes the print data and the print request to the one or more image forming apparatuses that includes the designated functions.

Whitmarsh '608 further discloses wherein the print instruction includes an instruction for designating functions to be used for printing the print data (paragraph [0041]-[0042], where via a browser there is provided a screen so that the user can make choices), and

the print request part selects one or more image forming apparatuses that includes the designated functions from among the selected one or more image forming apparatuses (paragraph [0043], where the user can select the destination printer among the ones shown in a list), and distributes the print data and the print request to the one or more image forming apparatuses that includes the designated functions (paragraph [0046], lines 1-7).

Having a system of Kato '111 reference and then given the well-established teaching of Whitmarsh '608 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato '111 to include wherein the print instruction includes an instruction for designating functions to be used for printing the print data, and the print request part selects one or more image forming apparatuses that includes the designated functions from among the selected one or more image forming apparatuses, and distributes the print data and the print request to the one or more image forming apparatuses that includes the designated functions as taught by Whitmarsh '608 because with this a user will have the choice to select what printer he/she will prefer to use for printing the image.

7. Claims 10, 23 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) in view of Shima (JP 2001209503 A, machine translation it's being used for the citations).

(1) regarding claims 10 and 23:

Kato '111 discloses all the subject matter as described above except wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address.

However, Shima '503 teaches wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address (paragraph [0009], where with the loop back address the system is able to perform this function).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the print request part requests the printing part of the image forming apparatus itself to print the print data by using a loop back address as taught by Shima '503, in the system of Kato '111. With this the development cost are reduced by dispensing with the development of an interface relying on each printing server (English abstract).

(2) regarding claims 30, 31 and 32:

Kato '111 discloses all the subject matter as described above, except wherein when an address of the image forming apparatus is stored in the storage unit due to selection of the image forming apparatus at the client terminal and when the image forming apparatus includes the function included in the print request, the print request

part requests a printing part of the image forming apparatus to print the print data by specifying a loop back address for returning the print data back within the image forming apparatus.

However, Shima '503 teaches wherein when an address of the image forming apparatus is stored in the storage unit due to selection of the image forming apparatus at the client terminal and when the image forming apparatus includes the function included in the print request, the print request part requests a printing part of the image forming apparatus to print the print data by specifying a loop back address for returning the print data back within the image forming apparatus (paragraph [0009], where with the loop back address the system is able to perform this function).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein when an address of the image forming apparatus is stored in the storage unit due to selection of the image forming apparatus at the client terminal and when the image forming apparatus includes the function included in the print request, the print request part requests a printing part of the image forming apparatus to print the print data by specifying a loop back address for returning the print data back within the image forming apparatus as taught by Shima '503, in the system of Kato '111. With this the development cost are reduced by dispensing with the development of an interface relying on each printing server (English abstract).

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) in view of Matsueda et al. (US 2001/0040692)).

Kato '111 discloses all the subject matter as described above except wherein when an error is output when the print request part either requests the printing part of the image forming apparatus to print the print data, or requests one or more of the other image forming apparatuses to print the print data, another image forming apparatus of the plurality of image forming apparatuses is selected and the print request part requests the another image forming apparatus to print the print data.

However, Matsueda '692 teaches wherein when an error is output when the print request part either requests the printing part of the image forming apparatus to print the print data, or requests one or more of the other image forming apparatuses to print the print data, another image forming apparatus of the plurality of image forming apparatuses is selected and the print request part requests the another image forming apparatus to print the print data (Fig. 3 and Fig. 4, where when an error is detected another printer is chosen).

Having a system of Kato '111 reference and then given the well-established teaching of Matsueda '692 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printer of Kato '111 to include wherein when an error is output when the print request part either requests the printing part of the image forming apparatus to print the print data, or requests one or more of the other image forming apparatuses to print the print data, another image forming apparatus of the plurality of image forming apparatuses is selected and the print request part requests the another image forming apparatus to print the print data as taught by Matsueda '692 because with this an image will always

going to get printed, even if the selected printer is not available, thus making it convenient for the user to always get an output.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Mon - Thur 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 2625